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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,755	07/24/2001	J. Michael Milliorn	P02166US0	5349
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FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
			EXAMINER HENDERSON, MARK T	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 12/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,755

Applicant(s)

MILLIORN, J. MICHAEL

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-21 and 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 14, 17 and 29 have been amended for further examination. Claims 12 and 22 have been canceled.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11, 13-21 and 23-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (6,420,006) in view of applicant's admittance.

Scott discloses in Fig. 2-5, an adhesive label comprising: polypropylene material; a first section (16a), a second section (24) each having a first side (20) and a second side (18), wherein the first side of the first section is contiguous with the first side of the second section, and wherein the second section forms a non-adhesive tab portion (24) extending from an edge (b) of the first section; a releasable adhesive layer (28) covering the first side (20) of the first section and configured such that the degree of adhesion is uniform such that the entire label detaches from a substrate surface (10) when the tab is pulled upon. Scott also discloses wherein the second side of the first portion is adapted to be written upon (Col. 4, lines 23-26). Scott further discloses: wherein the second section tab portion extending from the first section, wherein the second section tab portion has an edge (b) interconnected with the edge of the first section; and a label liner (38) holding a plurality of labels (Fig. 8-14), and adapted to form a roll (Fig. 15).

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However, Scott does not disclose: a label adapted to remained adhered to a substrate during exposure to various temperatures ranging between -40 degrees Celsius and 50 degrees Celsius and the entire label can be removed from the substrate after exposure to temperatures ranging from -40 degrees Celsius and 50 degree Celsius; and wherein the second side accepts printing related to food safety labeling systems; and wherein the interconnected edges form a rounded edge.

Applicant has admitted in the Specification on page 4 to the use of an adhesive which is adapted to remain adhered at temperatures ranging from -40 degrees Celsius to 50 degrees Celsius, yet is easily removable at the same temperatures.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scott's label to include adhesive which can remain adhered at temperatures ranging at -40 degrees Celsius to 50 degrees Celsius as taught by Applicant's admittance for the purpose of providing adhesion to an item exposed to various degrees of temperatures.

In regards to **Claims 7-11 and 23-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable indicia on the second side of the label such as food related indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983).

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Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Mere support by the substrate (second side surface) for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

In regards to **Claims 9-11, 26-33** with respect to the ink color, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Therefore, it would be obvious to one having ordinary skill in the art to modify the Scott reference with ink color of any desirable color, since the ink color would depend on the intended use of what the user wanted to display. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore the label of the Scott reference can have a graphical color that is related to an industry code used in food safety systems.

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In regards to **Claims 15-17**, it would have been an obvious matter of design choice to make the first section, the second section, and different portions of the interconnected edges of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Therefore, it would have been obvious to modify the Scott reference to include any surface area which can be lifted by a finger for the purpose of removing the label.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Milliorn et al discloses a similar label.

Response to Arguments

3. Applicant's arguments filed on September 30, 2003 have been fully considered but they are not persuasive.

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In response to applicant's argument that the prior art does not teach or disclose an adhesive that is adapted to adhere at temperatures ranging from -40 degree Celsius to 50 degree Celsius, the examiner submits that Applicant's admittance on page 4 of the specification to the use of an adhesive sold by AVERY DENNISON under the trade name FASSON R-10 can be used to adhere when subjected to particular temperature degrees. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Scott's label to include adhesive which can remain adhered at temperatures ranging at -40 degrees Celsius to 50 degrees Celsius as taught by Applicant's admittance for the purpose of providing adhesion to an item exposed to various degrees of temperatures.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 11, 2003



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700